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In the Supreme Court of the United States

OCTOBER TERM 1958

No. 630

GEUDER, PAESCHKE & FREY CO., A CORPORATION
Defendant-Petitioner

vs.

THE J. R. CLARK COMPANY, A CORPORATION, AND JOHN R. CLARK
Plaintiffs-Respondents

RESPONDENTS' BRIEF IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI

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FOREWORD

Respondents take no issue with respect to petitioner's statements concerning identification of the *Decisions Below* or of presently invoked *Jurisdiction*.

Respondents deny that the *"Questions Presented"*, stated in the Petition (p. 2) are present in the case, and challenge the *Statement Of This Case* (pp. 2-6) as well as the alleged *Reasons For Granting The Petition For Writ Of Certiorari* (pp. 6-11), as presented by petitioner.

RESPONDENTS' STATEMENT OF THE CASE

Under this Court's Rule 19, 1. review on writ of certiorari "will be granted only where there are special and important reasons therefor".

This is a conventional patent suit in which the petitioner, defendant below, ostensibly seeks a hearing by this Court on conventional patent questions of validity and infringement, whereas the real objective is apparently no more than to delay the final accounting and money damages to which the lower courts have unequivocally found respondents entitled.

The petitioner's contention that there is conflict between decisions of the Courts of Appeal for the Seventh and Ninth Circuits, on issues involved in this case, and for the purpose of invoking review under this Court's Rule 19, 1.(b), is without substance or merit, as will hereinafter be shown.

This action was brought May 12, 1954, and following interrogatories, the taking of depositions, and pre-trial conferences and briefs, a full trial was had in January, 1957. After additional briefing, and oral arguments, the trial court found for plaintiffs-respondents on all issues, the formal Judgment (A-126-7) being entered on December 19, 1957.

The Judgment decreed claim 1 of the Olander patent in suit to be valid and infringed, and awarded plaintiffs a perpetual injunction against defendant, as well as full recovery for profits and damages, with costs, etc.

The Writ of Permanent Injunction was issued January 6, 1958, and is presently still in effect since no staying supersedeas was filed.

The Opinion of the Court of Appeals for the Seventh Circuit, written by Chief Judge Duffy, and its Judgment, affirming the trial court, were entered October 10, 1958. The present Petition for Writ of Certiorari was filed a few days within the three months permitted under the statute and that without attempting to stay the Mandate.

Petitioner's factual representation of evidence, as given in the "*Statement Of This Case*" (pp. 4-6), is improper and misleading because it is argumentative and distorts or omits facts which must be recognized and accepted for purpose of this Petition. Thus—

(1) The Olander patent claim in suit, as corrected by Certificate of Correction, is the definition of invention that is relied on, both for validity and infringement. It must stand or fall on the language and wording found within itself, and as stated in the trial court's Finding No. 2 (A-115).

Petitioner's fact contention (p. 4) that the claim in suit when—

> "stripped of all formal verbiage, recites nothing more than the combination of an ironing board with single bar legs having transverse feet pivoted together at a point above their centers and with the upper portions lying adjacent to the vertical plane of one edge of the board."

is accordingly nothing less than a deliberate effort to substitute its own ambiguous and misleading interpretation of subject matter for that set forth in the claim. Thus, and entirely aside from various omissions, the above quoted language suggests that it may be the "feet" rather than the "bar legs" that are "pivoted together" and does not say *what* it is that has "upper portions lying adjacent to, etc."

So, too, petitioner (p. 4) lifts expressions (a) to (e) from specification context, and then apparently attacks validity on a theory that the stated "primary objects" should have been recited in the claim itself.

By petitioner's first interpretation the claim, "stripped of all formal verbiage", could be reduced to but a few words,

while the alternate conception would necessitate inclusion of a substantial part of the specification. Either would be very different from the claim as it is, and there is no justification for thus misleading this Honorable Court on a fact presentation which is clear in the patent itself and with which the lower courts had no problem.

(2) Petitioner admits (p. 5) that it (its officers) saw the Clark Model No. 10 ironing table when it was first displayed in January, 1953 at the National Housewares Exhibit in Chicago. Such admission, or the contention that defendant developed the accused Model C-690 prior to granting of the patent, are per se, clearly of no importance as far as any issues of this case are concerned.

The January, 1953 showing did, however, give rise to factual considerations that were extremely important to critical issues in this case, and as to them the present Petition is ominously silent.

Display of the No. 10 table at the Chicago Exhibit was extremely significant because of its impact on the industry and particularly on the defendant. This is reflected in the trial court's Findings 12 to 17, inclusive, in which it is made clear that the Olander invention was not only of radically different design, but that it solved a serious problem of long standing. Also that defendant immediately took steps to make and sell the infringing ironing table which was then characterized in the trade as being sensationally new.

(3). Other important facts which the petitioner conveniently omits include (a) the undisputed and uncontested Finding (No. 6, p. 116) that hand ironing is one of the most tiring, disagreeable and frustrating tasks of the housewife, that the fatigue factor has been the subject of scien-

tific studies, and that a great deal of thought and effort has been expended in solving this problem. (b) That (F. of F. 8, 9 and 10) the problem had existed for years and earlier attempts to solve it had failed. (c) That Olander's invention did solve the problem (F. of F. 11) and when placed on the market by both petitioner and respondent it completely displaced the previous deluxe models sold by both companies (F. of F. 16, 17, 18 and 27). (d) Finally that the Olander device was inventive and patentable over all prior art devices cited either in the Patent Office or by the defendant-petitioner (F. of F. 19, 20, 21, 22, 23 and 28).

(4) On the issue of infringement petitioner represents as a fact (p. 5) that "The *legs* of the C-690 table are offset from the center of the board but *not to an edge as in the Clark No. 10 table.*" This is misleading. As clearly shown in Fig. 2 (A. 133) only one leg (21) is offset to an edge of the board. The other leg bar 30 is inwardly thereof. This is clarified by the specification wherein the part 21 is described as being in "a vertical plane substantially coincident with the outer lateral edge of the board" (A. 140, Col. 3, lines 46-48), while the portion 30 of leg 18 is described as being in a plane "adjacent to and parallel with the vertical plane in which the leg portion 21 lies" (A. 140, Col. 4, lines 7-10).

On this showing the trial court concluded that the word "adjacent" was properly used to describe the relationship of both bars with respect to the vertical plane passing through one edge of the board, that it applied equally to both plaintiffs' and defendant's tables, and that the use of "adjacent" in a patent claim had been sanctioned and approved by judicial interpretation in given published decisions (F. of F. 24, A. 121).

The foregoing explanation is made merely to correct the erroneous fact presentation in the petition, and not because it has even a remote bearing on whether or not certiorari should be granted, for clearly it does not.

ARGUMENT

Petitioner's alleged reasons for seeking review are completely without merit.

The Petition is barren of any credible reason or argument for justifying certiorari.

(1) Respondents take no issue with petitioner's opening assertion (pp. 6-7) that petitioner and the public are entitled to engage in unfettered competition with plaintiff "though not entitled to infringe a valid patent claim."

(2) The implication (p. 7) that petitioner should escape liability because respondent only relied on one of several claims in the Olander patent is wholly without merit as is self-evident.

(3) The statement (p. 7) that the "objective" inferentially found in claim 1 "is achieved from the moving of the leg structure from the central area of the ironing board to an outer lateral edge" is grossly misleading because it erroneously suggests that there is a prior art structure having a leg structure which if so moved would meet the claim. There is definitely no such prior art structure here in evidence.

The extension of this argument, as found on pages 9 and 10 of the Petition adds nothing to its weight, and obviously the language quoted from claim 2 of the patent (not here in suit) can in no wise alter the scope or meaning of claim 1.

(4) Petitioner's characterization (p. 7) of claim 1 as defining nothing more than "a conglomeration of well known elements" is in brazen disregard of its own testimony (F. of F. 16 and 17) to the effect that the infringing table which it made was "the most efficient and best ironing table" it ever produced and when marketed became a "sensational" success completely displacing petitioner's previous best model.

(5) Reason 2 (p. 8) advanced by petitioner is that when the Olander patent issued "petitioner was already exhibiting and selling its Model C-690 ironing table which it had designed to compete with the plaintiffs' Clark Model 10 table." This fact is conceded but on what theory such fact can affect the issues in this case and particularly to form a basis for certiorari is not explained and is incomprehensible.

(6) The argument (p. 11) that under the judgment of the Court of Appeals "the claim in suit loses all distinction from the prior art as exemplified by the Mary Proctor board" apparently now limits reliance on prior art to that board but in any event flies into the teeth of uncontroverted facts. The first is that petitioner has not heretofore relied solely on Mary Proctor for anticipation, because it clearly does not meet the claim. Secondly, the trial judge specifically found (a) that the Mary Proctor "did not solve the problem that was solved by the Olander invention" (F. of F. 10, A. 117); and (b) that Mary Proctor "does not (even) suggest the invention of the patent in suit" from which it was as distinguishable as the Hild patent, rejected by the examiner, and as the Model C-680, which petitioner had discontinued (F. of F. 22, A. 120-121). These are findings which the Court of Appeals specifically affirmed

(Opinion p. A-4), and in *Goodyear Tire & Rubber Co. v. Ray-O-Vac Co.*, 321 U. S. 275, 64 S. Ct. 593, 594 this Honorable Court said "It must be a strong case in which this court will set aside these concurrent findings of two courts" (1944).

(7) Turning next to the alleged "conflict between decisions" petitioner's position (pp. 7-8) is equally untenable. The contention that either the original findings (A. 115-123), or the subsequent decision by the Court of Appeals for the Seventh Circuit are inconsistent with the Supreme Court decision in the *A. & P.* case (*Great Atlantic & Pacific Tea Co. v. Supermarket Equipment Corp.*, 240 U. S. 147, 71 S. Ct. 127), as construed by the Court of Appeals for the Ninth Circuit in *Kwikset Locks, Inc. v. Hillgren*, 210 F. 2d 483, and *Bergman v. Aluminum Lock*, 251 F. 2d 801, is sheer fiction, and gives rise to what can only be considered moot questions at best.

By pre-trial agreement of the parties, concurred in by the trial judge, the issues in this case were closely restricted to certain questions of fact and law (F. of F. 4). Those issues were then decided, and in considerable detail, in favor of respondent (A. 116-125). In like manner the Court of Appeals affirmed (259 F. 2d 737). That is all that either court was required to do.

Nor can such concurrent findings be said to fall short of the requirements in the *A. & P.* case, regardless of how or by what court they may be construed. Thus the findings (6, 8, 9, 10, 19, 20, 22) review the problems involved, and the efforts and failures by others to solve those problems.

The Olander ironing table is then described (F. of F. 11) as being "so constructed that it can be readily adjusted

to" perform several specific functions (F. of F. 7), the need for which had long been known, but which are not found in any single prior art device (F. of F. 19, 20, 21, 22 and 23). These findings are all affirmed and in fact supplemented by still more specific observations as to the structural and functional distinctions and advantages over the prior art.

In sustaining the claim in suit the Court of Appeals for the Seventh Circuit not only pointed out why it considered the Olander invention patentably distinguishable from the prior art, and a valuable contribution, but did so in a manner that clearly distinguishes this case from the three decisions relied upon by petitioner.

Thus, in the *A. & P.* case this Court's decision did not turn on academic prerequisites of claim language or findings, but rather on whether or not there existed "invention only in an extension of the (a) counter." The answer was negative because there was no "unusual or surprising consequences from the unification of the elements", and because the combination did not as a "whole in some way exceed the sum of its parts."

In the *Kwikset Locks* case the claims in question were not held invalid because of any deficiency in the trial court's findings, but because and only because that court had "failed to apply the strict standard for testing combination patents." In the lengthy *Bergman* decision the patent covered a mere drain slot in a shingle, which the court regarded as "at most—merely a mincing step forward." It did cite its earlier *Kwikset* decision in connection with a similar omission of finding, but this was *obiter dictum*, as the final holding was "invalid for want of novelty and invention" (p. 809).

In the present case the claim defines what the lower courts recognized as a completely new, novel and patentable combination of parts or elements, all so constructed and arranged as to solve an old, serious problem. The findings here of record, like those before this Court in *Williams Mfg. Co. v. United Shoe Mach. Co.*, 316 U. S. 364, 62 S. Ct. 1179 (at 1181)—

> "are to the effect that the new combinations, while they involve old mechanical constructions, combine these in a new way to produce an improved result. * * * The claim that the combinations are merely of old elements, which perform no new function and produce no new result, must be overruled."

CONCLUSION

The ironing table, today as in the past, stands as a symbol for tiring and disagreeable work. To the extent that the Olander invention has made that task easier and less disagreeable this case is important. To the extent that issues are presented of sufficient weight and consequence to justify the intervention of this Honorable Court this case is of no importance.

The Petition for Writ of Certiorari should accordingly be denied.

Respectfully submitted,

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NOTICE OF SERVICE

This is to certify that five copies of this brief have been served on Mr. Maxwell H. Herriott, counsel for petitioner, by mailing the same to him at his last known address, postage prepaid, this — day of January, 1959.

ANDREW E. CARLSEN.